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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,589	07/13/2001	Brian Paul Chadwick	28110/36120D	7125

7590 06/15/2004

LI-HSIEN RIN-LAURES
HYSEQ, INC.
670 ALMANOR AVENUE
SUNNYVALE, CA 94085

EXAMINER	
HUYNH, PHUONG N	
ART UNIT	**PAPER NUMBER**
1644	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/905,589	CHADWICK ET AL.	
	Examiner	Art Unit	
	Phuong Huynh	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *Three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/8/04; 3/29/04*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-26,28 and 29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-26,28 and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 19-26, 28 and 29 are pending.

2. The rejection of claims 19-26 under 35 U.S.C. 103(a) as being unpatentable over Smith *et al* (Biochim Biophys Acta 1386(1): 65-78, July 1998, PTO 892) in view of Harlow *et al* (in Antibodies a Laboratory Manual, 1988, Cold Spring harbor laboratory publication, Cold Spring Harbor, NY, pages 92-94, pages 116-117, pages 626-629) or Campbell *et al* (in Monoclonal Antibody Technology, 1984, Elsevier Science Publisher, New York, NY, page 1-32; PTO 892) is hereby withdrawn in view of the declaration filed on 3/8/04 under 37 CFR 1.131 by Walter Funk. The declaration is sufficient to overcome the Smith et al reference because the CD39L2 polypeptide was first invented by the inventors of the instant application (Chadwick and Frischauf) in a journal article which was made public June 15, 1998 (Chadwick and Frischauf et al, Genomics 50: 357-367, 1998) which precedes the publication of the Smith et al reference (Biochemica et Biophysica Acta 1386: 65-78, July 1998).

3. In view of the amendments filed 3/29/04 and 3/8/04, the following rejection remains.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 19-26 and 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,476,211B1 (Nov 2002, PTO 892).

The '211 patent teaches an isolated antibody such as monoclonal and polyclonal antibody and binding fragment thereof that bind specifically to CD39L2 polypeptide having the amino acid sequence 100% identical to the claimed SEQ ID NO: 2 (See column 63, lines 1-9, column 20 bridging column 20, lines 1-65 and column 21, lines 1-3, in particular). The '211 patent further teaches the reference antibody is labeled with a detectable label such as radioisotope, affinity label such as biotin, enzymatic label such as horseradish peroxidase, fluorescent label such as

FITC or paramagnetic atoms (See column 20, lines 55-5, in particular). The '211 patent further teaches a method of making hybridoma that produces the reference monoclonal antibody (See column 20, line 40-45, in particular). The '211 patent also teach a kit comprising the reference antibody and polypeptide or immunologically reactive fragment thereof with a wash agent or agent capable of detecting the bound antibody for diagnostic assays (See column 24, lines 35-56, in particular). Thus, the reference teachings anticipate the claimed invention.

Applicants' arguments filed 3/29/04 and 3/8/04have been fully considered but are not found persuasive.

Applicants' position is that the '211 patent teaches antibodies that recognize only amino acid residues 121-134 of CD39L2. Claims have been amended to exclude CD39L2 antibodies that bind to amino acid residues 121-134 of CD39L2.

In response, this rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131 since the instant application and the issued patent have common assignee.

6. The following new ground of rejection is necessitated by the amendment filed amendment filed 3/29/04 and 3/8/04.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 19-26 and 28-29 are rejected under 35 U.S.C. 112, first paragraph, containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

The "...excluding antibody or antigen binding fragment thereof which specifically binds to a CD39L2 polypeptide consisting of amino acid residues 121 through 134" in Claim 19 represents a departure from the specification and the claims as originally filed. The specification does not appear to disclose any antibody that binds to the residues 121 through 134 of CD39L2

polypeptide. It would be helpful if applicants would point out where in the specification that term at issue may be found.

9. No claim is allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Huynh "NEON" whose telephone number is (571) 272-0846. The examiner can normally be reached Monday through Friday from 9:00 am to 5:30 p.m. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The IFW official Fax number is (703) 872-9306.

12. Any information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuong N. Huynh, Ph.D.

Patent Examiner
Technology Center 1600
June 14, 2004

CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600